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| APPLICATION NO.                                                       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|-----------------------------------------------------------------------|-------------|----------------------|------------------------------|------------------|
| 09/736,055                                                            | 12/13/2000  | Steven W. Lopez      | 7704-10                      | 6587             |
| 30448                                                                 | 7590        | 01/17/2007           |                              |                  |
| AKERMAN SENTERFITT<br>P.O. BOX 3188<br>WEST PALM BEACH, FL 33402-3188 |             |                      | EXAMINER<br>BORISSOV, IGOR N |                  |

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3628     |              |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|----------------------------------------|------------|---------------|
| 31 DAYS                                | 01/17/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/736,055

Applicant(s)

LOPEZ, STEVEN W.

Examiner

Igor N. Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22,24-47 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22,24-47 and 52-61 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- A. Claims 1-19 and 37-42, drawn to a system for article handling with image separation, classified in class 382, subclass 175.
- B. Claims 20-30 and 57, drawn to a system for article handling with image processing, classified in class 209, subclass 584.
- C. Claims 31-36, 43-47, 52, 53 and 56 drawn to a method and system for variable speed conveyors, classified in class 198, subclass 460.1.
- D. Claims 54-55, drawn to a method for image analysis and labeling, classified in class 382, subclass 180.
- E. Claims 58-61, drawn to a method for scanning articles, classified in class 382, subclass 101.

Inventions A, B, C, D and E are related as subcombinations disclosed as usable together in a single combination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

In the instant case, the invention A as claimed does not require the particulars of the invention B as claimed, because Invention A requires: separating the scanned image into discrete data groups, and the invention B has separate utility such as scanning the separate receiver location address indicators and sender return address indicator of each mailpiece.

Because these inventions are distinct for the reasons given above and have

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acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In the instant case, the invention A as claimed does not require the particulars of the invention C as claimed, because Invention A requires a transponder for receiving mailpieces, and the invention C has separate utility such as: a conveyor driven by a motor responsive to a mailpiece size sensor to feed mailpieces at rates determined by mailpiece size.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In the instant case, the invention A as claimed does not require the particulars of the invention D as claimed, because Invention A requires: separating the scanned image into discrete data groups, and the invention D has separate utility such as: generating images sized to fit within preselected dimensions of an area space as to be positioned on a mailpiece having a preselected size.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In the instant case, the invention A as claimed does not require the particulars of the invention E as claimed, because Invention A requires: a mailpiece feeder to individually feed intermixed mailpieces; and a transporter for transporting said mailpieces; and a labeler, and the invention E has separate utility such as: imaging a

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return-to-sender indicator; using said image creating a modified return-to-sender indicator.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

### ***Species***

In the event applicant elects Invention A above, he/she is further obligated to elect among the following species as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: Claims 1-9, 14-19 and 37-42.

Species 2: 10-13.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An arrangement that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of the generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or

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otherwise include all the limitations of an allowed generic claim as provided by 37 CFR

1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. (MPEP 809.02(a)).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

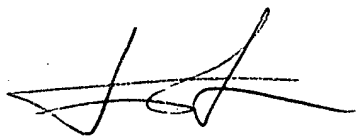
Due to the complexity of the case, applicant is being afforded the courtesy of a written response.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB  
01/07/2007



IGOR N. BORISSOV  
PRIMARY EXAMINER